

Remarks**I. Response to Claims Objections:**

At page 2, item 1 of the Office Action claims 14, 30, and 31 are objected to as being of improper dependent form for failing to limit the subject matter of a previous claim.

In response to the claim objections, the Applicants have cancelled claims 14, 30, and 31.

II. Response to Claims Rejections under 35 USC 102:

At page 3, item 3 of the Office Action, claims 1-6, 10, 11, 13-16, 19, and 30-32 are rejected under 35 USC Section 102 as being anticipated by Donohue (US Patent number 5,978,450, hereinafter referred to as "Donohue". However, Donohue does not disclose a system, method, or storage device that includes the limitations of the Applicants amended independent claims. More specifically, Donohue does not disclose a document delivery system that includes a virtual editor "to selectively retrieve the plurality of the received content objects to construct a customized publication, constructed from the plurality of content objects, for a requesting user based, at least in part, on a user profile", as recited in amended independent claim 1. Nor does Donohue disclose a method of generating a publication that includes "dynamically generating a publication constructed from the plurality of received content objects based, at least in part, on a user profile", as recited in amended independent claim 15. Nor does Donohue disclose a storage device comprising executable instructions that implements "a virtual editor service to receive a plurality of content objects from one or more content providers, store the received content objects, and to selectively retrieve content objects to construct a customized publication constructed from the plurality of content objects in accordance with a user profile", as recited in amended independent claim 32.

In Donohue, a method and system for delivering documents customized for a particular user over the Internet using imbedded dynamic content is described. Thus, although Donohue refers to the document as being "customized" (as pointed out in the Examiner's citation of column 11, lines 21-25 of Donohue), the customization is restricted to the customization of a *single content object that is formatted by way of a template* to be viewed within a customer's particular browser.

At column 2, lines 14-16, Donohue lists the candidate browsers "including several variations of Mosaic, Netscape Communications Corporation's Netscape Navigator, Microsoft Corporation's Internet Explorer, TradeWave Galaxy's MacWeb, and Oracle's PowerBrowser".

Further, at column 12, lines 27-38, Donohue discloses "As mentioned above, in preferred embodiments of the present invention, the process of selecting templates involves performing additional steps to achieve certain advantageous results. To provide customized documents which are automatically compatible with the user's browser type, a number of templates are designed and stored which provide the same or similar content but which are designed to be compatible with different browsers. The different browsers have the same filename but different extensions which are indicative of the type of browser they support, e.g., N20 for Netscape version 2.0, N30 for Netscape version 3.0, etc."

Thus, the Applicants contend that Donohue does not construct a "customized publication constructed from the plurality of content objects", as recited in amended independent claims 1, 15, and 32. (Claim language may vary slightly.) In contrast, Donohue merely formats a *single* content object so that the content can be viewed in a browser window.

Accordingly, the Applicants request that the Examiner withdraw the rejection to the claims.

III. Response to Claims Rejections under 35 USC 103:

At page 5, item 5 of the Office Action, claims 7, 12, 18, 24, 25, 33, and 34 are rejected as being unpatentable over Donohue, as identified hereinabove. The Applicants traverse the rejection since Donohue does not suggest, mention, or otherwise make obvious a document delivery system that includes a virtual editor "to selectively retrieve the plurality of the received content objects to construct a customized publication, constructed from the plurality of content objects, for a requesting user based, at least in part, on a user profile", as recited in amended independent claim 1. Nor does Donohue suggest, mention, or otherwise make obvious a method of generating a publication that includes "dynamically generating a publication constructed from the plurality of received content objects based, at least in part, on a user profile", as recited in amended independent claim 15. Nor does Donohue suggest, mention, or otherwise make obvious a storage device comprising a executable instructions that implements "a virtual editor service to receive a plurality of content objects from one or more content providers, store the received

content objects, and to selectively retrieve content objects to construct a customized publication constructed from the plurality of content objects in accordance with a user profile", as recited in amended independent claim 32.

As previously mentioned hereinabove, with regard to the rejection under 35 USC Section 102, Donohue discloses a method and system for delivering documents customized for a particular user over the internet using imbedded dynamic content. Thus, although Donohue refers to the document as being "customized" (as pointed out in the Examiner's citation of column 11, lines 21-25 of Donohue), the customization is restricted to the customization of a *single content object that is formatted by way of a template* to be viewed within a customer's particular browser. At column 2, lines 14-16, Donohue lists the candidate browsers "including several variations of Mosaic, Netscape Communications Corporation's Netscape Navigator, Microsoft Corporation's Internet Explorer, TradeWave Galaxy's MacWeb, and Oracle's PowerBrowser".

Further, at column 12, lines 27-38, Donohue discloses "As mentioned above, in preferred embodiments of the present invention, the process of selecting templates involves performing additional steps to achieve certain advantageous results. To provide customized documents which are automatically compatible with the user's browser type, a number of templates are designed and stored which provide the same or similar content but which are designed to be compatible with different browsers. The different browsers have the same filename but different extensions which are indicative of the type of browser they support, e.g., N20 for Netscape version 2.0, N30 for Netscape version 3.0, etc."

Thus, the Applicants contend that Donohue does not construct a "customized publication constructed from the plurality of content objects", as recited in amended independent claims 1, 15, and 32. In contrast, Donohue merely formats a *single content object* so that the content can be viewed in a browser window.

Further, since Donohue "customizes" only the format of a single content object, this "customization" cannot be performed in accordance with, or based on, the "user profile" as recited in amended claims 1, 15, and 32. In Donohue, any user-specific information serves only to determine which one of templates 24 is used to present the single content object to the user. But this user specific information is not a "user profile" as present in the Applicants' claims.

Accordingly, the Applicants request that the Examiner withdraw the rejection to the claims.

In regards to the Examiner's "Official Notice" of pages 5-6 of the Office Action, the Applicants challenge the assertion that the marking wrapper of claims 7, 24, and

34 represents an obvious variation of the plain brown wrapper that accompanies a conventional publication. As recited in unamended claim 7 and amended claims 24 and 34, "the non-invasive marking wrapper including a unique marker to identify distribution, receipt and user disposition of the content object throughout the document distribution system". Thus, as the marking wrapper identifies (among other thing) the "disposition of the document through the system", this is in sharp contrast to the function of a plain brown wrapper, which merely identifies the subscriber to whom the publication is delivered.

The Applicants respectfully request that the Examiner either present one or more references that either disclose or make unpatentable the claimed invention, or else withdraw the rejection.

In regards to the Examiner's "Official Notice" of pages 6-7 of the Office Action, the Applicants challenge the assertion that "publishing select content objects from one content provider with respect to content objects from another content provider" (as recited in claims 12, 17 and 18 - claim language may vary slightly) is old and well known. The Examiner's example of placing an alcohol product with an article on the dangers of drunk driving is not persuasive. For example, one beer company includes the words "drink responsibly" on the label of the product. Further, a cigarette package is marked with warnings about the dangers of tobacco.

If the Examiner believes that the invention of claims 12, 17, and 18 is indeed "old and well known" the Applicants respectfully request that the Examiner either present one or more references either that disclose or make unpatentable the claimed invention, or withdraw the rejection.

At page 8, item 6 of the Office Action, claims 8, 20-22, 26, 27, 29, 35, and 36 are rejected as being unpatentable over Donohue in view of Rapaport (US patent number 5,890,152, hereinafter referred to as "Rapaport"). The Applicants respectfully traverse the rejection since the combination does not suggest, mention, or otherwise make obvious the limitation of the Applicants' claims.

As previously mentioned herein, Donohue does not suggest, mention, or otherwise make obvious a document delivery system that includes a virtual editor "to selectively retrieve the plurality of the received content objects to construct a customized publication, constructed from the plurality of content objects, for a requesting user based, at least in part, on a user profile", as recited in amended independent claim 1. Nor does Donohue suggest, mention, or otherwise make obvious a method of generating a publication that includes "dynamically generating a publication constructed from the plurality of received content objects based, at least

in part, on a user profile", as recited in amended independent claim 15. Nor does Donohue suggest, mention, or otherwise make obvious a storage device comprising a executable instructions that implements "a virtual editor service to receive a plurality of content objects from one or more content providers, store the received content objects, and to selectively retrieve content objects to construct a customized publication constructed from the plurality of content objects in accordance with a user profile", as recited in amended independent claim 32.

Donohue discloses a method and system for delivering documents customized for a particular user over the internet using imbedded dynamic content. Thus, although Donohue refers to the document as being "customized", the customization is restricted to the customization of a *single content object that is formatted by way of a template* to be viewed within a customer's particular browser. At column 2, lines 14-16, Donohue lists the candidate browsers "including several variations of Mosaic, Netscape Communications Corporation's Netscape Navigator, Microsoft Corporation's Internet Explorer, TradeWave Galaxy's MacWeb, and Oracle's PowerBrowser" Further, since Donohue "customizes" only the format of a single content object, this "customization" cannot be performed in accordance with, or based on, the "user profile" as recited in amended claims 1, 15, and 32. In Donohue, any user-specific information serves only to determine which one of templates 24 is used to present the single content object to the user. But this user specific information is not a "user profile" as present in the Applicants' claims.

In Rapaport, a personal feedback browser selects media files based on user-specified information stored in the Personal Profile database. According to the attention that the user gives to the file, the personal profile database is updated. However, Rapaport merely provides a stream of articles that may interest the viewer. Rapaport does not suggest, mention or otherwise make obvious "a customized publication constructed from the plurality of content objects" as recited in amended independent claim 1. Nor does Rapaport suggest, mention, or otherwise make obvious, a method of generating a publication that includes "dynamically generating a publication constructed from the plurality of received content objects based, at least in part, on a user profile", as recited in amended independent claim 15. Nor does Rapaport suggest, mention, or otherwise make obvious a storage device comprising a executable instructions that implements "a virtual editor service to receive a plurality of content objects from one or more content providers, store the received content objects, and to selectively retrieve content objects to construct a customized publication constructed from the plurality of content objects in accordance with a user profile", as recited in amended independent claim 32.

When taken together, the combination of the references does not make suggest, mention, or make obvious the invention of claims 1, 15, and 32. Since both references are silent on the aspect of "constructing" a publication from a plurality of content objects" the combination of the references cannot be combined to produce the missing limitation.

Accordingly, the Applicants request that the Examiner withdraw the rejection to the claims.

At page 9 of the Office Action, claims 9, 23, 28, and 37 are rejected under 35 USC 103 as being unpatentable over Donohue in view of Rapaport, and further in view of Griebenow (US patent number 5,850,520, hereinafter referred to as Griebenow). The Applicants respectfully traverse this rejection since there is no motivation to combine the references.

As previously mentioned neither Donohue nor Rapaport include any teaching of a system, method, or a storage device that includes executable code that includes the aspect of "constructing" a publication from a plurality of content objects. On the other hand, Griebenow discloses a method and system for electronic publication distribution including return receipt. In Griebenow, an electronic publication (which may include a plurality of content objects) is delivered electronically to a subscriber's electronic mail box.

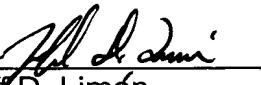
However, the Examiner has not shown proper motivation to combine the cited references. As neither Donohue nor Rapaport pertain to presenting single content objects to the user, and wherein Griebenow pertains to delivering entire publications, the Applicants assert that these references do not reflect a proper combination. Before obviousness may be established, the Examiner must show that there is either a suggestion in the art to produce the claimed invention or a compelling motivation based on sound scientific principles. Also, the suggestion or motivation must be accompanied by a general knowledge of the existence of techniques recognized in the art for carrying out the proposed invention. In particular, there is no showing in Donohue or in Rapaport that would motivate one of skill in the art to modify the teachings of the references to move from formatting single content objects to preparing entire electronic publications, as disclosed by Griebenow.

Accordingly, the Applicants respectfully request that the Examiner withdraw all rejections to the claims.

IV. Additional Fees:

It is not believed that additional fees are due at this time; however, if any additional fee is required in connection with the filing of this Amendment, please charge the fee to Deposit Account No. 08-2025.

Respectfully Submitted,
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